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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,079	03/29/2001	Shigeyuki Kawai	SON-1846/STP	6806

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,079

Applicant(s)

KAWAI ET AL.

Examiner

Bradley Bayat

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*mw*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Status of Claims***

The applicant has canceled claims 1-4 and added new claims 12-17 in the amendment filed on 18 March 2004. Therefore, claims 5-17 are presented for examination on the merits.

### ***Response to Arguments***

Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive.

As per claims 5-11, the applicant contends that the cited reference, Tomoyuki et al. (5,991,747), disclose an electronic purse loan system wherein repayment may be set for monthly installments and charges can be loaned many times within the term for repayment, however, it does not disclose a "minimum" payment as part of an accumulated installment balance (applicant's response pages 5-6). The applicant further argues that the examiner's official notice of the use of a contact-less card as being old and well-known in the IC card and computer industry is unsupported and hindsight reasoning (applicant's response pages 6-7). The examiner respectfully disagrees.

The examiner asserts that the cited reference effectively provides for a "minimum" payment without using the applicant's terminology. As Tomoyuki discloses, if the cardholder has not reached it's maximum loan limit (upper limit), she is presented with the opportunity to either take out another loan up to the limit or rather clear all or part of the outstanding loan to further expand the line of credit or loan amount (column 7). By definition and as described in the cited reference, repayment terms and loan limits are established by the parties prior to assuming a loan by a cardholder (column 10). Therefore, in the case of for example more than

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one installment loan, the minimum payment to acquire another loan could be the difference between the upper limit and outstanding balance or perhaps other repayment terms established by the parties (see columns 10-11). As the cited reference discloses, a loan may be made plural times by setting the upper limit of a loan and the term of repayment, or the times of a loan (column 14).

The examiner adds a reference after applicant's rebuttal regarding official notice of contact-less cards, and the newly cited reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection. Since no amendments are made to the claims, the examiner does not rely on any other teachings in the reference. See MPEP § 706.07(a).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As per new claims 12-17, the applicant argues that the cited reference "fails to disclose, teach or suggest an amount of money used by a user from the amount of money data inputted in an information card, and fails to disclose, teach or suggest means for receiving any part of all of an installment balance accumulated in the installment transaction history data, as an installment amount of payment (applicant's response page 9)." And the applicant further contends that

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Tomoyuki fails to disclose means for accumulating transaction history data and installment balance management (Id.).

As Tomoyuki points out in the background of the invention (column 1), the object of the invention is to enable correspondence only by the electronic purse system without using another transaction method, such prior art methods well known in the art such as cash or credit card. As Tomoyuki points out, prior art methods of adding cash or using credit card to add credit to prepaid cards is well known. The card user as per Tomoyuki can determine balance date at any time wherein the transaction data is managed utilizing loan information data, date information, loan repayment terms in the loan data storage center (see figures 2a,b and associated text). Moreover, Tomoyuki describes an example wherein electronic money information relating to the sum of loan and card user information is stored in the IC card (figure 13 and associated text).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 5-9, 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Tomoyuki et al, U.S. Patent 5,991,747**

As per the following claims, Tomoyuki et al. discloses:

5. A transaction method by means of an electronic device which contains monetary value as electronic money, characterized in that said transaction method accumulates the amount data

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equivalent to transaction amounts as installment transaction history data and receives part or all of the accumulated installment balance as a minimum payment (figures 5 and 10 and associated text).

6. The transaction method by means of an electronic device according to claim 5, characterized in that said minimum payment is decided freely for each transaction (figure 4 and associated text).

7. The transaction method by means of an electronic device according to claim 5, characterized in that said electronic money is capable of credit transactions and that a plurality of transactions are settled in one communication exchange (columns 1-2).

8. The transaction method by means of an electronic device according to claim 5, characterized in that said installment transaction history data is sent to installment management means (figures 3-4 and associated text).

9. The transaction method by means of an electronic device according to claim 5, characterized in that said electronic device is a card sized storage medium (figures 1, 13 and associated text).

11. The transaction method by means of an electronic device according to claim 5, characterized in that said electronic device is a portable terminal (figure 1, 13 and associated text).

12. An electronic money system including electronic money terminals adapted to withdraw amount of money data equivalent to an amount of money used by a user from the amount of money data inputted in an information card, the system comprising: means for accumulating installment transaction data history data, each installment transaction history data including the

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amount of money data for payment by the information card when the payment by installment is selected (figures 2a, 2b, 5, 10 and associated text); means for receiving any part or all of an installment balance accumulated in the installment transaction history data, as an installment amount of payment (column 2, lines 20-41); an installment balance management system for determining a balance by subtracting the installment amount received by the receiving means, from the installment balance to send the installment balance of the information card (columns 10-11); and means for sending the installment transaction history data in the installment transaction history data accumulation means to the installment balance management means (figures 9, 11 and associated text).

13. The electronic money system according to claim 12, wherein said installment transaction history accumulation means comprises: a first accumulation means for accumulating the installment transaction history data in the electronic money terminal according to the payment of the user, and a second accumulation means for gathering from the electronic money terminal and accumulating the installment transaction history data accumulated in the electronic money terminal by the first accumulation means (figures 12, 13 and associated text).

14. The electronic money system according to claim 12, wherein the receiving means sets a minimum value of the installment amount of payment according to the installment balance (column 8).

15. The electronic money system of claim 12, wherein said installment amount of payment is a total amount of installment balance data collected from a plurality of the electronic money terminals (column 8).

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Claims 16 and 17 are rejected as above, encompassing and directed to the same limitations of the above claims.

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomoyuki et al., U.S. Patent 5,991,747.**

Tomoyuki discloses a transaction method by means of an electronic device which contains monetary value as electronic money, characterized in that said transaction method accumulates the amount data equivalent to transaction amounts as installment transaction history data and receives part or all of the accumulated installment balance as a minimum payment (figures 5 and 10 and associated text). Tomoyuki fails to explicitly teach the use of a contact-less information card that sends and receives data. Official notice is taken that contact-less data



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cards is an old and well-known type of card processing method in the chip and smart card computer art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement Tomoyuki's electronic purse system utilizing contact-less cards thereby avoiding the common problems of warping or stress after prolonged usage, resulting in disturbed electrical connections and ultimately a lower level of reliability.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

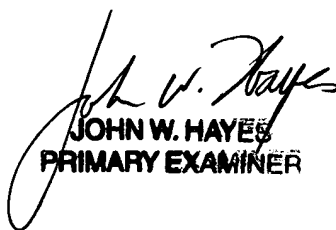
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JOHN W. HAYES**  
**PRIMARY EXAMINER**